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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,483	08/14/2001	Wataru Sasaki	32739M054	7895

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EXAMINER

LEE, TOMMY D

ART UNIT PAPER NUMBER

2624

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/928,483	<b>Applicant(s)</b> SASAKI ET AL.	
	<b>Examiner</b> Thomas D. Lee	<b>Art Unit</b> 2624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 15, 16, 22, 23, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10-12, 17-19 and 24-26 is/are rejected.
- 7) ☒ Claim(s) 4-6, 13, 14, 20, 21, 27 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040712</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, 10-14, 17-21 and 24-28, drawn to read area designation based on read size and direction of original, classified in class 358, subclass 1.18.
  - II. Claims 7-9, 15, 16, 22, 23, 29 and 30, drawn to stand-by state transmission to scanner, classified in class 358, subclass 434.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as designation of a standby mode for simple scanning of an image, without regard to its size or orientation. See MPEP § 806.05(d).
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Michael A. Makuch (Registration No. 32,263) on March 10, 2005 a provisional election was made with traverse to prosecute

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the invention of read area designation based on read size and direction of original, claims 1-6, 10-14, 17-21 and 24-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-9, 15, 16, 22, 23, 29 and 30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Specification***

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 10, 11, 17, 18, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,778,276 (Hasegawa).

Regarding claims 1 and 2, Hasegawa discloses a scanner system comprising an image scanner for scanning image data of an original (image reading unit 3 (column 5, lines 12-18)) and a control device for controlling the image scanner (system control unit 2 including CPU (column 5, lines 8-11)), wherein the control device includes: first setting means for accepting input for setting a reading size of an original (CPU determines size of original document by receiving signals from detect sensors 81, 82, 83 (column 9, line 63 – column 10, line 23)); second setting means for accepting input for setting a direction of the original (detect sensors output signals, enabling the CPU to determine size and direction of original document (column 10, lines 28-42; Fig. 9)); and scanning instruction means for designating a reading area of the original based on the inputs of the reading size and the direction of the original that have been accepted by the first and second setting means and outputting a scan execution instruction to the image scanner (system control unit controls limits of an effective area for preliminary scanning motion based on size and direction of the original document as detected by the detect sensors (column 18, line 53 – column 19, line 3)). The scanning instruction means designates the reading area such that an end part of an area readable by the image scanner coincides with an end part of the reading area (image reading unit receives instruction from system control unit to move a mirror unit mounted on the image reading unit, for a distance corresponding to the longitudinal limit of the detected size (column 18, line 62 – column 19, line 3)).

Claims 10 and 11, 17 and 18, and 24 and 25 are similar in scope to above-rejected claims 1 and 2, except that claim 10 recites a scanner driver installed in a

computer connectable to an image scanner, claim 17 further recites a recording medium readable by the computer, and claim 24 recites a signal transmittable via a communication line being modulated by data corresponding to the scanner driver installed in the computer. These limitations read on the system control unit of Hasegawa. The system control unit, which includes a CPU, RAM and ROM (column 5, lines 8-11), communicates signals with image reading unit 3, image processing unit 4 and mechanical drive unit 11 (Fig. 1A) for performing size and direction of an original document according to a program stored in ROM (column 5, lines 23-28).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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11. Claims 3, 12, 19, 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa as applied to claims 1, 10, 17 and 24 above, respectively, and further in view of U.S. Patent 6,859,287 (Frederiksen et al.).

Hasegawa does not appear to disclose third setting means for accepting input of a scanning starting location and a scanning ending location for setting a reading area, wherein the scanning instruction means designates an area that has been set by the third setting means as the reading area. This limitation is disclosed in Frederiksen et al. According to Frederiksen et al., document size may be detected automatically, or may be set manually by means of an original settings button (Abstract; column 4, lines 1-10). The original settings button, when combined with the teaching of Hasegawa, would provide a third setting means for manually setting a size (start and end scanning locations inherently determined according to the document size) of a document to be scanned, along with the setting means for automatically determining a size and direction of a document in Hasegawa. Manual selection of a document size allows a user to override automatic size detection by detecting sensors, in case copying of irregularly shaped documents is required (column 3, lines 9-19), thus enhancing the versatility of the scanner system. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Hasegawa by providing for manual selection of document size, as disclosed in Frederiksen et al.

***Allowable Subject Matter***

12. Claims 4-6, 13, 14, 20, 21, 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: No prior art has been found to disclose or suggest applicant's means for setting a scanning execution standby mode and transmission means, as recited in dependent claims 4, 13, 20 and 27, *included in scanning instruction means for designating a reading area of the original based on the inputs of the reading size and the direction of the original that has been accepted by first and second setting means* as recited in base claims 1, 10, 17 and 24.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,842,265 (Votipka et al.) discloses an image display orientation control apparatus comprising a first setting that causes an image of an object scanned by a scanner apparatus to be displayed in a first orientation, and a second setting that causes the image to be displayed in a second orientation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee  
Primary Examiner  
Art Unit 2624

tdl  
March 16, 2005